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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,399	12/23/2004	Koji Okomori	47172	2492
1609 7590 11/19/2009 ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036				
EXAMINER				
BAREFORD, KATHERINE A				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
11/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/501,399

Applicant(s)

OKOMORI ET AL.

Examiner

Katherine A. Bareford

Art Unit

1792

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 5-7 and 19-24.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Katherine A. Bareford/
Primary Examiner, Art Unit 1792

Continuation of 3. NOTE: the amendment to claim 19 to put the features of claim 24 into claim 19 raises new issues that would require further consideration and/or search by the Examiner because dependent claims 20-23 did not previously require the features of claim 24 and the addition of these features would change the scope of those claims.

Continuation of 11. does NOT place the application in condition for allowance because: (a) the 35 USC 112 rejection of claims 5-7 is not overcome because the proposed amendment has not been entered as discussed in Box 3 above. (b) The previous 35 USC rejections of 5-7 and 19-23 are maintained for the reasons give in the Final Rejection of June 16, 2009, because the proposed amendments to the claims have not been entered as discussed in Box 3 above, and applicant only argued the claims as with the combination of claim 19 with claim 24. (c) As to the 35 USC 103 rejection of claim 24 (as presently pending) using Wurster in view of Japan '392, Applicant argues that Wurster is directed to lightweight coated paper and specifically operates at lower speeds than the claimed invention, citing the examples in Wurster as including a jet flow such as a Massey coater or a scraper such as an inverted blade. The Examiner disagrees that the description of possible application processes at column 4 limit the speed of the coating application. Wurster specifically provides that various application processes "such as . . ." may be used, indicating that others can be used as well, and further provides "The paper according to the invention is therefore essentially independent of the type of coat application process" (column 4, lines 28-30). The Massey coater or KCM coaters described by applicant would thus merely be optional methods that can be used and do not limit the potential speed of application. As to the use of '392, applicant argues that this reference uses more starch than claimed or used by Wurster and also that this high starch specifically corrects problems of using high speed gate coaters as described in '392, and since Wurster uses a lower amount of starch, one skilled in the art would expect misting and boiling and would not be motivated to use '392 with Wurster's composition. The Examiner disagrees. Wurster teaches using roll coating processes in general (column 4, line 25), one of ordinary skill in the art would clearly look to the art of coating materials with pigment and adhesive by roll coating to determine desirable roll coating processes and speeds to use, and '392 would be relevant as it is also directed to making coated offset paper for offset printing, with coating with pigment and adhesive, and teaches a desirable roll coating system and speed. As to the use of high amounts of starch to allow for the high speed coating, the Examiner disagrees that '392 is so limited. '392 discusses that high speed coating can be provided by control of features other than starch, such as concentration or viscosity (paragraph [0010]), and thus one of ordinary skill in the art would expect that the roll coating system of '392 would be successfully usable with the coating materials described by Wurster. As to applicant's argument that coated papers containing more than 2 parts by weight of starch is not suitable for offset printing with more than 7g/m² coating per side leading to further problems, the Examiner notes that no showing has been made as to this issue and Wurster appears to contradict this statement as it makes offset printing paper and allows coating with 0-10 percent by weight starch and coat weights more than 7 g/m² per side. As to the benefits provided by the combination of claimed features, as discussed in paragraph 10(B) of the Final Rejection of June 16, 2009, no showing commensurate in scope with what is claimed has been made using the applicator roll system as claimed in claim 24 and the claimed range of polyvinyl alcohol and starch. .